REMARKS

Claims 6, 8-12, 14-18, 23, 27, 29, 31, 39, 47, and 48 are pending in the present Application. No claims have been cancelled, amended, or added, leaving Claims 6, 8-12, 14-18, 23, 27, 29, 31, 39, 47, and 48 for consideration upon entry of the present Response. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 6, 8-10, 12, 14-18, 27, 31 and 39 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,306,507 to Brunelle et al. or U.S. Patent No. 6,265,522 to Brunelle et al. or Publication No. WO 00/61664 to Pickett et al. in view of U.S. Patent No. 6,720,386 to Gaggar et al. or Applicant's Admissions. Applicants respectfully traverse this rejection.

Claim 12 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,306,507 to Brunelle et al. or U.S. Patent No. 6,265,522 to Brunelle et al. or Publication No. WO 00/61664 to Pickett et al. in view of U.S. Patent No. 6,720,386 to Gaggar et al. or Applicant's Admissions, and further in view of U.S. Patent No. 6,780,917 to Hashimoto et al. Applicants respectfully traverse this rejection.

Claim 31 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,306,507 to Brunelle et al. or U.S. Patent No. 6,265,522 to Brunelle et al. or Patent No. WO 00/61664 to Pickett et al. in view of U.S. Patent No. 6,720,386 to Gaggar et al. or Applicant's Admissions, and further in view of U.S. Patent No. 5,080,950 to Burke. Applicants respectfully traverse this rejection. Although Applicants contend that it would not be obvious to combine these references as suggested in the Office Action, the specifics are not addressed herein since they are moot.

Applicants submitted a petition for an unintentionally delayed claim for priority to claim the present application as a continuation-in-part of U.S. Patent No. 6,689,474, issued December 10, 2004. U.S. Patent No. 6,689,474 is a continuation-in-part of U.S. Patent No. 6,306,507, i.e., Brunelle et al. Additionally, U.S. Patent No. 6,265,522 to Brunelle is a

divisional of Brunelle '507. Hence, Brunelle '507 predates Brunelle '522, and neither reference is a proper 35 U.S.C. §103 reference against the present application. The petition for the delayed claim of priority was accepted and acknowledged by the Examiner. However, the Office Action dated July 11, 2008 (hereinafter "OA 07/08") states that Applicant's claim for the benefit of a prior filed application has been acknowledged, but alleges that the

> parent applications 10/310,295 (filed 12/5/2002) and 09/908,396 (filed 7/18/2001) and 09/368,708 (filed 8/5/1999) as originally filed do[]not provide support for a substantial number of the present claims.

(OA 07/08, Page 2) As a result, Claims 6, 8-10, 12, 14-18, 27, 31, and 39 are deemed by OA 07/08 to have an effective filing date of December 30, 2003. (Please note that Applicants assume that when OA 07/08 refers to application serial number 09/368,708, that OA 07/08 was actually referring to 09/368,706, as noted above, because there is no such application with serial number 09/368,708.)

Applicants respectfully disagree and submit that 35 U.S.C. §120 requires that

> An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Applicants also respectfully submit that 37 C.F.R. §1.78(a)(1) and (a)(2) require that

> (a)(1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112.

As is evident from the fact that Applicants' petition was granted, Applicants have fully complied with the requirements under 35 U.S.C. §120 and 37 C.F.R. §1.78.

OA 07/08 alleges that

> if Applicant contends that the parent applications provide support for the above listed claims, the Applicant should point out *with specificity* the portions of *each* parent application which provide support for each claim in order to establish the alleged effective filing date of for each claim.

(OA 07/08, Pages 10-11) Applicants respectfully disagree and submit that

> As in cases involving the enablement requirement of 35 U.S.C. § 112, e.g., *In re Armbruster*, 512 F.2d 676, 185 USPQ 152 (Cust. & Pat.App. 1975), we are of the opinion that *the PTO has the initial burden of presenting evidence* or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims."

In re Wertheim, 541 F.2d at 263 (*emphasis* added). Moreover,

> The burden of showing that the claimed invention is not described in the specification *rests on the PTO in the first instance*, and it is up to the PTO to give sufficient reasons why a description not in ipsis verbsis is insufficient.

Id. at 265 (*emphasis* added). Thus, since Applicants have fully complied with the requirements under 35 U.S.C. §120 and 37 C.F.R. §1.78, and since OA 07/08 fails to present evidence that the claims are not supported by the priority documents, the PTO has not met its burden of showing that the claims are not described in the specification of application serial number 09/368,706; 09/908,396; or 10/310,295, the rejections are improper. Additionally, U.S. Patent No. 6,306,507 to Brunelle et al., U.S. Patent No. 6,265,522 to Brunelle et al., and Pickett (publication number WO 00/61664, this reference published October 19, 2000; over a year *after* the filing of Brunelle '507), are not proper 35 U.S.C. §103 references against the present application. If the Examiner disagrees, the Examiner is requested to specifically explain how these references qualify as prior art.

Reconsideration and withdrawal of this rejection are respectfully requested.

Double Patenting

Claims 6, 8-12, 14, 23, 27, 29, 31, 39 and 47-48 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

Claims 1-37 of copending Application No. 10/895,522 ('522 case) (U.S. Patent Publication No. 2006/0017193) in view of U.S. Patent No. 6,720,386 to Gaggar et al. or Applicant's Admissions. Claims 11-12 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-37 of copending Application No. 10/895,522 (U.S. Patent Publication No. 2006/0017193) in view of U.S. Patent No. 6,720,386 to Gaggar et al. or Applicant's Admissions, and further in view of U.S. Patent No. 6,780,917 to Hashimoto et al. Claim 31 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-37 of copending Application No. 10/895,522 (U.S. Patent Publication No. 2006/0017193) in view of U.S. Patent No. 6,720,386 to Gaggar et al. or Applicant's Admissions, and further in view of U.S. Patent No. 5,080,950 to Burke.

As neither the '522 application nor the present application have issued or been allowed, the claims are not final in both cases. It therefore is not possible to make any determination as to double patenting or obviousness at this time. Hence, it is requested that this rejection be held in abeyance at least until the present claims are allowed and the '522 case has issued. MPEP § 804.01.I(B)(1).

Allowable Claims

Applicants respectfully request confirmation of the allowability of Claims 11, 23, 29, and 47-48, which are deemed to have an effective filing date of August 5, 1999 and to which there are no objections or rejections listed in OA 07/08.

It is believed that the foregoing remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the objection(s) and rejection(s) and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-3621.

Respectfully submitted,

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